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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,292	12/28/2000	Eric R. Skinner	0500.0005051	9859

23418 7590 12/17/2004

VEDDER PRICE KAUFMAN & KAMMHOLZ
222 N. LASALLE STREET
CHICAGO, IL 60601

EXAMINER

SONG, HOSUK

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 12/17/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,292

Applicant(s)

SKINNER ET AL.

Examiner

Hosuk Song

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/3/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Applicant's arguments

1. Claims 1-20 are pending. The previous grounds of rejection based on Vaeth and Veil patents are withdrawn in view of Applicant's arguments in the Amendment filed 8/3/2004. However, newly discovered prior art has necessitated new grounds of rejection. The new grounds of rejection are presented below. The delay in citation of the newly discovered prior art is regretted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-7,12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al.(US 6,345,288).

Claim 1: Reed discloses receiving a confirmation request form from a server for digital signing by a digital signing process in (fig.1,2 and col.87,lines 5-8;col.111,lines 35-45). Reed discloses digitally signing the confirmation request form in response to confirmation data received in response to displaying the copy of the original transaction data in (col.123,lines 4-14). Reed does not specifically disclose temporarily maintaining the confirmation request form in volatile memory associated with a client unit. It would have been obvious to person of ordinary skill in the art to modify invention of Reed to employ a volatile memory for storing temporary data such as request form/certificate because volatile memory such as RAM offers higher access speed and since data are often accessed, it is advantageous to use a RAM since the

Art Unit: 2135

data access uses up less energy than for example, access data in an EEPROM. Further, RAM also has advantage that, when the battery voltage is switched off, the data in the memory are lost so that unauthorized person can no longer read out the data in the RAM.

Claim 2,4: Reed discloses confirmation request form includes at least one mark up language form that includes user entered data, at least one field name and form formatting information, all of which are presented for display to the user for acceptance and for receiving a digital signature in (col.111,lines 35-50 and fig.1).

Claim 3: Reed discloses sending the signed confirmation request form to a server for signature verification wherein the server compares a stored copy of the confirmation request form as it existed prior to receiving the digital signature, with the received digitally signed confirmation request form in(fig.7 and col.111,lines 45-67).

Claim 5: Reed discloses receiving the confirmation request form includes receiving a transaction confirmation request from a server in (col.87,lines 5-20).

Claim 6: Reed discloses wherein steps (a) and (b) are performed under control of a non-proxy cryptographic software application in (fig.28).

Claim 7: Reed discloses wherein step © is performed under control of a web browser in (fig.2).

Claim 12: Reed discloses receiving a confirmation request form from a server for digital signing by a digital signing process in (fig.1,2 and col.87,lines 5-8;col.111,lines 35-45). Reed discloses digitally signing the confirmation request form in response to confirmation data received in response to displaying the copy of the original transaction data in (col.123,lines 4-14). Reed does not specifically disclose temporary maintaining the confirmation request form in volatile memory associated with a client unit. It would have been obvious to person of ordinary skill in the art to modify invention of Reed to employ a volatile memory for storing temporary

Art Unit: 2135

data such as request form/certificate because volatile memory such as RAM offers higher access speed and since data are often accessed, it is advantageous to use a RAM since the data access uses up less energy than for example, access data in an EEPROM. Further, RAM also has advantage that, when the battery voltage is switched off, the data in the memory are lost so that unauthorized person can no longer read out the data in the RAM.

Claims 13-16: Reed discloses confirmation request form includes at least one mark up language form that includes user entered data, at least one field name and form formatting information, all of which are presented for display to the user, by the web browser for acceptance and to the non-proxy cryptographic application to receive a digital signature in (col.111,lines 35-50 and fig.1,28).

Claim 17: Reed discloses memory containing executable instructions that when read by one or more processing units, causes the one or more processing units to receive confirmation request form from a server for digital signing by a digital signing process in (fig.1). Reed discloses digitally signing the confirmation request form in response to confirmation data received in response to displaying the copy of the original transaction data in (col.87,lines 5-14;col.123,lines 4-14). Reed does not specifically disclose temporarily maintaining the confirmation request form in volatile memory associated with a client unit. It would have been obvious to person of ordinary skill in the art to modify invention of Reed to employ a volatile memory for storing temporary data such as request form/certificate because volatile memory such as RAM offers higher access speed and since data are often accessed, it is advantageous to use a RAM since the data access uses up less energy than for example, access data in an EEPROM. Further, RAM also has advantage that, when the battery voltage is switched off, the data in the memory are lost so that unauthorized person can no longer read out the data in the RAM.

Claim 18: Reed discloses confirmation request form includes at least one mark up language form that includes user entered data, at least one field name and form formatting information, all of which are presented for display to the user for acceptance and for receiving a digital signature in (col.111,lines 35-50 and fig.1).

Claims 19,20: Reed discloses memory includes executable instructions that when executed by the one or more processing units causes the one or more processing units to send the signed confirmation request form to a server for signature verification in (fig.1 and col.111,lines 35-65).

Allowable Subject Matter

3. Claims 8-11 are allowed.

Claim 8: Prior art of record does not teach receiving by a web browser associated with a client unit, an incomplete mark up language form, including at least one field name and form formatting information and presenting by the web browser the incomplete mark up language form for completion and submission to the receiving unit;launching in response to a completed form submission request including a confirmation request form that includes the at least user entered data, the associated field name and form formatting information, for digital signing by the non proxy cryptographic application.

Claims 9-11 are allowed because of dependency.

Conclusion

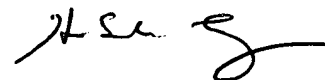
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri from 5:30 am to 4:00 pm.

Art Unit: 2135

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HS

A handwritten signature in black ink, appearing to be "H. S. G." or similar, located in the lower right quadrant of the page.